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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/021,875

12/17/2001

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7217/66060

2738

530 7590 08/30/2007
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EXAMINER

VAN HANDEL, MICHAEL P

ART UNIT

PAPER NUMBER

2623

MAIL DATE

DELIVERY MODE

08/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/021,875

Applicant(s)

KANO ET AL.

Examiner

Michael Van Handel

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u> </u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an Amendment filed 6/08/2007. Claims **1-56** are pending. Claims **1, 4, 8, 11, 16, 19, 26, 29, 34, 37, 40, 43, 46, 49, 52, and 55** are amended. The examiner hereby withdraws the objections to claims **4, 11, 19, 29, 37, 43, 49, and 55** in light of the amendment.

Response to Arguments

1. Applicant's arguments regarding the limitations of "said additional information including at least information of an artist of the audio program, an identifier of the digital radio broadcast, a broadcast time stamp, and lyrics of the audio program" of claims **1, 8, 16, 26, 34, 40, 46, and 52**, filed 6/08/2007, have been considered, but are moot in view of the new ground(s) of rejection.

2. Applicant's arguments regarding the limitation of "the key information comprising a program category preset by a user" of claims **1, 8, 16, 26, 34, 40, 46, and 52**, filed 6/08/2007, have been fully considered, but they are not persuasive.

Regarding claims **1, 8, 16, 26, 34, 40, 46, and 52**, the applicant argues that neither Benjamin et al. or Marko et al. discloses analogous key information, which includes a program category preset by a user as required in the present claims. The examiner respectfully disagrees. Benjamin et al. discloses allowing a user to add genre criteria to a play list for automatically

Art Unit: 2623

adding tracks (col. 13, l. 47-60 & col. 14, l. 45-51). The examiner notes that a genre is a class or category of artistic endeavor (see <http://dictionary.reference.com/browse/genre>). Since Benjamin et al. discloses that a user can set genre criteria to search tracks and only add tracks matching the genre criteria to the play list, the examiner maintains that Benjamin et al. meets the limitation of “the key information comprising a program category preset by a user,” as currently claimed.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims **1-56** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claims **1, 8, 16, 26, 34, 40, 46, and 52**, the examiner notes that the applicant has amended the claims to include subject matter, which Applicant disclosed as prior art in the background of the specification. The examiner acknowledges Applicant's description of different proposed types of additional information including (1) ID of broadcasting service, (2) information regarding program content, (3) timestamp, and (4) text data showing words of a song broadcast in the program. The examiner notes; however, that there is insufficient description to

Art Unit: 2623

suggest that additional information associated with a program includes *all* of the aforementioned proposed types (*italicized for emphasis*). The examiner interprets the limitations in the Office Action below as different types of additional information that can be associated with a program, as suggested by Applicant's specification.

Claims 2-7, 9-15, 17-25, 27-33, 35-39, 41-45, 47-51, and 53-56 are rejected as being dependent on claims 1, 8, 16, 26, 34, 40, 46, and 52, respectively.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benjamin et al. in view of Marko et al. and further in view of Applicant's admitted prior art.

Referring to claims 1, 8, 16, 26, 34, 40, 46, and 52, note the rejections under 35 USC 112, first paragraph above. Benjamin et al. discloses a receiver/information processing terminal/method of storing/transferring additional information, comprising the steps of:

- receiving additional information obtained and transferred in which the additional information is multiplexed with an audio program; said additional information including at least information of an artist of the audio program (col. 8, l. 4-13)(col. 14, l. 28-46)(Fig. 13);

Art Unit: 2623

- determining whether preset key information is included in the additional information, the key information comprising a program category preset by a user (the examiner notes that the tag includes a genre field and that the user can set specific genres as play list criteria)(col. 13, l. 47-55, 59-61 & col. 14, l. 45-49);
- transferring the additional information to an information processing terminal (selected device) when the key information is included (col. 13, l. 30-32); and
- storing the additional information without the audio program in a storage medium only when the preset key information is determined to be included (col. 5, l. 43-50)(col. 12, l. 51-66)(col. 13, l. 33-34)(col. 14, l. 14-21, 28-51).

Benyamin et al. does not disclose that the additional information is obtained and transferred by a receiver receiving a digital radio broadcast. Marko et al. discloses a digital radio broadcast receiver that receives content comprising auxiliary information (col. 4, l. 24-27, 36-46)(col. 5, l. 41-51)(Fig. 1)(Fig. 6). Marko et al. further discloses storing the content on a storage medium from which it is transferred to a device (the examiner notes that the content could be transferred to the computer 124 of Benyamin et al. and that Benyamin et al. discloses multiple methods of acquiring content (Benyamin et al. col. 8, l. 4-11))(Marko et al. col. 7, l. 16-22)(Fig. 7). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Benyamin et al. to receive digital radio broadcast content, such as that taught by Marko et al. in order to record a composite data stream and retrieve selected content therefrom (Marko et al. col. 2, l. 43-45).

The combination of Benyamin et al. and Marko et al. teaches automatically searching digital radio broadcast headers or footers for user-specified criteria and adding the media to a playlist if the criteria are met. The combination of Benyamin et al. and Marko et al. fails to teach that the headers or footers include an identifier of the digital radio broadcast, a broadcast time stamp, and lyrics of the audio program. The examiner notes that the related prior art section of Applicant's specification admits a list of proposed types of additional information as prior art. The list of additional information includes: (1) ID of broadcasting service, and information such as title and category; (2) information regarding program content, e.g., information such as artist name and song title in the case of a music program; (3) timestamp (time-of-day information); and (4) other accompanying information, for example, text data showing words of a song broadcast in the program (Applicant's specification, p. 2). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the header or footer information in the combination of Benyamin et al. and Marko et al. to include an ID of broadcasting service, information regarding program content, a timestamp, and text data showing words of a song broadcast in the program, such as that taught by Applicant's admitted prior art in order to allow a user to better retrieve select content for playback (Marko et al. col. 2, l. 43-45).

Referring to claim 46, Benyamin et al. further discloses that the technology for creating and updating play lists can be implemented on other devices (the examiner notes that the technology could be included on the receiver of Marko et al. The tracks satisfying the play list criteria would then be transferred to pc 124 and finally to the selected device.)(col. 17, l. 61-67).

Referring to claims 2, 9, 17, 27, 35, 39, 41, 47, and 53, Benyamin et al. discloses a receiver/information processing terminal/method of storing/transferring additional information,

Art Unit: 2623

wherein when the additional information includes a data portion consisting of a payload and a header portion consisting of information associated with the payload, information included in the header portion of the additional information is set as the key information, and when the key information is included in the header portion, the additional information including the header portion is stored in the storage medium (col. 14, l. 49-51)(col. 13, l. 33-34).

Referring to claims 3, 10, 18, 28, 36, 42, 48, and 54, Benyamin et al. discloses a receiver/information processing terminal/method of storing/transferring additional information, wherein when the additional information includes a data portion consisting of a payload and a header portion consisting of information associated with the payload, information included in the header portion of the additional information is set as the key information, and when the key information is included in the header portion, the data portion associated with the header portion is stored in the storage medium (this limitation is taught by the citation noted in claim 2 above).

Referring to claims 4, 11, 19, 29, 37, 43, 49, and 55, Benyamin et al. discloses a receiver/information processing terminal/method of storing/transferring additional information, wherein said step of storing/transferring stores/transfers, in addition to the additional information including the key information, main information of the associated program in the storage medium (this limitation is taught by the citation noted in claim 2 above).

Referring to claims 5, 20, 38, 44, 50, and 56, Benyamin et al. discloses an information processing terminal/method of storing additional information, wherein said step of storing stores accompanying information in association with the additional information (this limitation is taught by the citation noted in claim 2 above).

Referring to claims **6, 12, 21, 30, 45, and 51**, the combination of Benyamin et al. and Marko et al. discloses a receiver/method of storing/transferring additional information, wherein said receiver also receives further information of a program other the program being received and transfers the further additional information (Marko et al. col. 5, l. 41-51).

Referring to claims **7, 13, 22, and 31**, the combination of Benyamin et al. and Marko et al. teaches a receiver/method of storing/transferring additional information, further comprising the steps of transferring the additional information stored in the storage medium to a receiver, wherein the receiver displays the transferred additional information on a display unit thereof (the examiner notes that Marko et al. teaches playing back content on the receiver)(col. 6, l. 11-18)(col. 7, l. 47-51).

Referring to claims **14, 23, and 32**, the combination of Benyamin et al. and Marko et al. teaches a receiver/method of transferring additional information, wherein a step of determining stores additional information in a storage means when it is determined that the key information is included (col. 14, l. 49-51)(col. 13, l. 33-34). Benyamin et al. further discloses automatically updating play lists by use of a trigger when tracks are made accessible (col. 15, l. 1-14, 17-19, 23-27). The combination of Benyamin et al. and Marko et al. does not teach a step of transferring that transfers the additional information to an external device at a predetermined timing. The examiner takes Official Notice that it is well known within the prior art to trigger the transfer of data such that the transfer takes place at a predetermined time. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the trigger of Benyamin et al. in the combination of Benyamin et al. and Marko et al. to transfer data

Art Unit: 2623

at a predetermined time such as that taught by the prior art in order to limit the consumption of processing resources.

Referring to claims **15**, **25**, and **33**, the combination of Benyamin et al. and Marko et al. teaches a receiver/method of transferring additional information, wherein a step of determining stores additional information in a storage means when it is determined that key information is included (col. 14, l. 49-51)(col. 13, l. 33-34). The combination of Benyamin et al. and Marko et al. does not teach a step of transferring that deletes the additional information from the storage means after the additional information has been transferred. The examiner takes Official Notice that it is well known within the prior art to delete data from storage after the data has been transferred (cutting and pasting files, for example). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the method of transferring files taught by the combination of Benyamin et al. and Marko et al. to include deleting data from storage after the data has been transferred such as that taught by the prior art in order to free up more memory space.

Referring to claim **24**, the combination of Benyamin et al. and Marko et al. teaches a method of storing additional information. Benyamin et al. further discloses transferring tracks to a selected device in response to a trigger (col. 13, l. 29-34)(col. 15, l. 1-14, 17-19, 23-27). The combination of Benyamin et al. and Marko et al. does not teach a step of transferring that transfers additional information in response to a transfer request. The examiner takes Official Notice that it is well known within the prior art to download data to a receiving device in response to a transfer request from the device. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the method of transferring files

Art Unit: 2623

taught by the combination of Benyamin et al. and Marko et al. to include triggering the transfer of files in response to a download request from the selected device such as that taught by the prior art in order to ease the transfer of files from a device that is at a remote location from the receiving device.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

Art Unit: 2623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MVH


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